Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
PHLY-26,664	

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Signature _____

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Application Number	Filed
10/791,678	2004-03-02
First Named Inventor	
JEFFRY JOVAN PHILYAW	
Art Unit	**Examiner**
2141	KENNETH R. COULTER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 30,646
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Gregory M. Howison, Reg. #30,646/
Signature

GREGORY M. HOWISON
Typed or printed name

972-479-0462
Telephone number

2008-04-21
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of ONE forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Jeffry Jovan Philyaw
Serial No.:	10/791,678
Filed:	March 2, 2004
Group:	2141
Examiner:	Kenneth R. Coulter
For:	METHOD AND APPARATUS FOR ACCESSING A REMOTE LOCATION BY SENSING A MACHINE-RESOLVABLE CODE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Please consider the following reasons in support of the concurrently filed Pre-Appeal Brief Request for Review.

In the final rejection mailed on October 19, 2007, claims 1-36 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,152,369 to *Wilz, Sr* ("*Wilz*").

In the present application, the Examiner proposes a reference that does not teach, expressly or inherently, each and every limitation found in Applicants' currently presented claims. Therefore, the Examiner has failed to provide a single prior art reference that anticipates Applicants' present inventive concept as defined by the claims. Specifically, Applicants submit that the §102 rejection based on *Wilz* is not proper and is without basis, and that the Examiner has failed to state a *prima facie* case as to how this reference anticipates under 35 U.S.C. § 102(e).

I. No Single Prior Art Reference That Teaches Each and Every Limitation.

A. Applicants submit that there is clear error with respect to the Examiner's rejection of claims 1-36 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,152,369 to *Wilz* ("*Wilz*"). As detailed at length on pages 10-13 of Applicant's Response (filed August 7, 2007, in response to the Office Action dated February 7, 2007), the rejections of claims 1-36 are deficient because the cited reference does not teach, expressly or inherently, each and every limitation contained in the claims of the instant application.

B. As Applicants state in the Response dated August 7, 2007, Applicants do not see how the Examiner is applying the cited portion of *Wilz* to the claims of the instant application. In the Final Office Action, it is offered that terms "software identification code" and "unrelated" are not well defined in the specification of the present application. A conclusion is drawn that the "software identification code" of Claim 1 and Claim 17 can possibly be interpreted as one of the fields in Figure 11B.

However, the specification sets forth in paragraph 0072 on page 45: "Running on the PC 302 is a software application 2520 which *includes a software identification code 2522*." Further, the specification defines the software identification code on Figures 25, 26 and 27 as well as in paragraphs 0074, 0076, 0077, 0079 and 0080. The term "unrelated" is found within originally filed Claim 1, as filed on March 2, 2004; and is, therefore, considered part of the originally filed patent application. Applicants submit that the plain meaning of "unrelated" is defined as "lacking a causal or logical relation." Also, the specification describes the machine resolvable code as reference number 2506 in paragraphs 0072, 0073, 0078 and 0079 in a manner that lacks a causal or logical relationship to the software identification code. Therefore, Applicants respectfully submit that the descriptions of the software identification code (2522) and the machine resolvable code (2506) illustrate no causal or logical relation. *Wilz* contains no teaching regarding a software identification code as recited by the claims of the instant application.

Previously, Applicants stated: "[in] the portion of the specification set forth, it refers to Fig. 11. Fig. 11 sets forth the server and the software and the only discussion is of the RDBMS (55) that operates at the server. This is the database structure." Column 27, lines 22-62, the Abstract, Figs 4, 5, 11A and 11B have been provided in the Final Office Action in response to Applicants' statement. However, the cited portions in *Wilz* describe a package tracking system (See *Wilz* starting at

Column 26, line 26). The *Wilz* system uses a first computer, interfaced with a scanner, to connect to a RTD computer via a pre-defined URL. The RTD computer, running a RDBMS software used to construct a Relational Database Management System (RDBMS), assigns a unique package ID to a package that is being logged into the system by the first computer. The RTD computer assigns the package a unique HTML-encoded information storage location and then links the URL of this location to the package ID. Then, the first computer encodes a UPC symbol with the URL and prints a UPC to be affixed to the package. Thereafter, any computer connected to the network can scan the UPC and access the URL associated to the UPC, e.g., the unique HTML-encoded information storage location.

Claim 1, of the instant application, requires providing a first computer disposed on the network, the first computer being interfaceable to an input device for sensing a machine-resolvable code proximate a first location. Claim 1 further recites that the first computer runs a software application which includes a software identification code unrelated to the machine resolvable code. The claim recites that the software identification code has an association with at least one remote location on the network. *Wilz* does teach a logging computer (52) and portable package delivery (PPD) computers (54) that are disposed on a network and interfaceable with an input device for sensing a machine resolvable code. However, *Wilz* does not disclose that the logging computer (52) and the portable Package Delivery Computer (PPD) (54) run a software application. The only software application disclosed in *Wilz* is the RDBMS software, which resides on the RTD (51). The RTD (51) is not interfaceable to the input device for sensing a machine-resolvable code. Furthermore, the only code associated with a location on the network is the UPC (i.e., the machine-resolvable code). As such, *Wilz* contains no discussion of a software identification code that is unrelated to the machine resolvable code that has an association with at least one or more remote locations.

Further, Claim 1 recites accessing, with the first computer, a second computer disposed on the network in accordance with routing information provided by the first computer and in response to sensing by the input device the machine-resolvable code proximate the first location; and then, transferring to the second computer from the first computer at least the software identification code. *Wilz* teaches that the logging computer (52) or PPD (54) access an information storage field in a web-page database on the RTD Information Server (51) in response to scanning the UPC on the

package. However, the routing information is encoded in, and thus, provided by, the UPC on the package, not provided by the logging computer (52) or PPD (54). Further, as Applicants previously stated: "all that is discussed in this portion of the specification is the transfer of a URL to a particular location to provide a look-up operation in the database in the first field. The URL that is transferred is a URL (5a)."

Claim 1 further recites storing in an associative database at the second computer, associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations. However, the *Wilz* database only stores an association between a URL and information about the package. As Applicants previously stated "[this] is basically what a bar code is typically used for, i.e., a database pointer. Thus, Applicants do not believe that this portion of the specification sets forth any association between a software identification code and a remote location. The only code that is discussed is the URL that is on the package."

The Claim further recites that a look-up operation is performed at the second computer to match the software identification code with the associated at least one or more of the remote locations. *Wilz* only discloses a URL that is encoded in a bar code that is used as nothing more than a database pointer. This allows the association between the URL and the database field illustrated in Fig. 11b to be accessed. Further, the second paragraph on page 6 of the Office Action sets forth the examiners position that the remote routing information is returned to the first computer that corresponds to the software identification code. Applicants believe this is incorrect and the Applicants also believe there is no step of accessing with the first computer the one or more remote locations in accordance with the returned remote routing information.

Applicants' present invention, as defined by the amended claims, is directed toward a system that is operable to access information about software running on a PC in response to the scanning of a machine resolvable code (MRC). Once the software identification code associated with this software is accessed, then this software identification code can be transmitted to an intermediate site. At the intermediate site, there is provided an associative database that contains associations between different software identification codes and one or more of the remote locations on the network. The matching remote location information, in the form of a routing URL, is then transferred back to the first computer or user's PC to allow the computer then to access a particular site. Therefore, the

routing to a particular site is initiated by the operation of scanning a particular MRC but the actual direction is provided by the software code. Therefore, it is not necessary for the information in the MRC to be utilized for the navigation operation but, rather, the navigation is conditioned upon what the software code comprises. This software identification code is also a code that is an integral part of the software and is accessible after the software is installed on the user's PC.

Conclusion

Applicants submit that single reference cited by the Examiner fails to fully anticipate Applicants' inventive concept as defined by the presented claims. Further, the cited reference fails to teach each and every limitation, expressly or inherently because the text fails to illustrate "why" one skilled in the art would see no difference between the instant application and the cited reference. Instead, the Examiner simply identifies particular components from the reference, construes them in a specific manner required by Applicants' claimed invention, and then states that the cited reference anticipates. This is clearly conclusory reasoning that contravenes the standards imposed by both the MPEP and the Federal Circuit, and Applicants respectfully submit that the cited reference is improper for reasons detailed above and requests that the rejections under § 102 and objections be withdrawn, as the Examiner has failed to present a *prima facie* case that each and every element is shown or anticipated by this single reference.

In the event that the rejection is to be maintained under 35 U.S.C. § 102, Applicants respectfully request that the Office, in the interests of compact prosecution, identify on record and with specificity sufficient to support a *prima facie* case of anticipation, where in the *Wilz* reference that each and every feature of Claims 1 and 17, and more specifically, where the software identification code of Claims 1 and 17 is alleged to be taught. It is respectfully submitted that all the claims in the application are in condition for allowance.

Respectfully submitted,
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